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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,994	06/08/2001	Bruno Biatry	208594US0	8350

22850 7590 12/31/2002

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/875,994

Applicant(s)

BIATRY, BRUNO

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2002 has been entered. Claims 1-24 and 26-31 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24 and 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "dull" and "dirty" in claim 24 are relative terms which render the claim indefinite. The terms "dull" and "dirty" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The remaining claims are rejected as depending on an indefinite base claim.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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1. Claims 1-24 and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ribier et al. (U.S. Pat. No. 6,071, 524) ("Ribier I").

Ribier I discloses compositions for skin, where in an oily phase, stabilized by cubic gel particles formed of phytanetriol, is dispersed in an aqueous phase. See col. 1, line 7- col. 2, line 18. See Examples 6 and 7, which are directed to day creams for skin protection. The reference further discloses the specific limitations of instant claims 7-22, 27, and 30. See col. 3, line 9 – col. 9, line 19.

Topically applying a cosmetic is an inherent use of the composition. The claimed method is inherently practiced by any users of the Ribier I invention. Applicants' assertion urban populations using the Ribier I invention would not desire the benefit of the composition claimed by applicants lacks evidentiary support and does not render the present invention novel.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derwent Acc. No. 1986-321473 (English abstract of JP 61236737 A) ("Kuraray abstract" hereunder).

Kuraray abstract states, "[p]hytanetriol is known as useful cosmetic component with protective action for skin or hair." See Basic-Abstract.

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While the reference does not specifically teach to use the effective amount to protect the skin from pollution penetration, given the general teaching of the protective function of phytanetriol, one having ordinary skill in the art at the time the invention was made would have discovered the workable amount of the active ingredient by routine experimentation.

2. Claims 2, 3, 5, 6, 15, 17-19, 21, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuraray abstract as applied to claims 1, 23, and 24 above, and further in view of Ribier et al. (U.S. Pat. No. 5,834,018) ("Ribier II").

Kuraray abstract, discussed above, fails to teach the specific formulation of the composition.

Ribier II teaches aqueous composition of cubic gel particles based on 0.1-15% by weight of phytanetriol. See abstract.

Given the general teaching that phytanetriol provides protective action for skin, a one having ordinary skill in the art at the time the invention was made would have been motivated to look for specific formulations comprising phytanetriol such as Ribier II and applied the prior art invention with the expectation that the Ribier invention would successfully protect the skin.

3. Claims 2-4, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuraray abstract as applied to claims 1, 23, and 24 as above, and further in view of Murad (U.S. Pat. No. 6,207,694 B1).

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Kuraray abstract, discussed above, fails to teach the specific formulation of the composition.

Murad teaches a composition for prevention and treatment of hair and scalp condition comprising phytanetriol. See abstract; Examples 2, 3, 5, and 7-9. The use of the composition encompasses reducing hair and scalp damages from exposure to pollution or overdrying. See instant claims 1, 23, and 24. See col. 5, lines 5 – 12; 9, lines 17 – 21. Examples 2, 3, 5, and 7-9 illustrate formulations comprising phytanetriol in the amount of 0.02 – 0.3 % by weight of the total composition. See instant claims 2 and 3. The formulas are also homogenous mixture of oil and aqueous phases. See instant claims 4, 26, and 29 are met. Examples 5, 7, and 8 are directed to scalp formulation. See instant claims 28 and 31.

Given the general teaching that phytanetriol provides protective action for hair or skin, a skilled artisan would have been motivated to look for the specific formulations such as the Murad invention, and to apply the composition with the expectation that it would successfully protect hair and scalp.

4. Claims 2-4, 26, and 29 are rejected under 35 U.S.C. § 103 (a) as unpatentable over Kuraray abstract as applied to claims 1, 23, and 24 above, and further in view of Bergmann (U.S. Pat. No. 6,110,450).

Kuraray abstract, discussed above, fails to teach the specific formulation of the composition.

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Bergmann teaches composition for the treatment and protection of hair, comprising glycoceramide and phytanetriol. See abstract. The term "protection" in the reference includes the protection of the hair fibers from the harmful agents from unsuitable hair treatments (and inclement weather). See col. 1, line 17 - 26. Examiner views that applicant's broad definition of pollutant, which include gases or "heavy metals", encompasses the harmful metal agents from the hair treatment products. See spec. p. 2, lines 22-24. Examples 1 and 2 show emulsion formulations comprising phytanetriol in the amount of 0.1 % by weight of the total composition. See instant claims 2-4, 26, and 29.

Given the general teaching that phytanetriol provides protective action for hair or skin, one having ordinary skill in the art at the time the invention was made would have been motivated to apply the Bergmann composition with the expectation that the Bergmann invention would successfully protect hair and scalp.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-24 and 26-31 have been considered but are unpersuasive in part and moot in view of the new ground(s) of rejection in part.

Applicants' argue that the Ribier I references does not teach the claimed method of using a phytanetriol-containing composition. Examiner reiterates that the claimed method is inherently practiced by the topical application of the same composition as taught by the reference. Examiner finds it unpersuasive that the function of phytanetriol that applicants assert somehow does not exist in the Ribier I invention.

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**Conclusion**

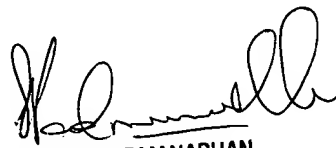
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
December 27, 2002

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

12/30/02